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PATENT COOPERATION TREATY

PCT

RECD 25 JAN 2002

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference SPER-100PCT	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/US00/23874	International filing date (day/month/year) 30 AUGUST 2000	Priority date (day/month/year) 01 SEPTEMBER 1999
International Patent Classification (IPC) or national classification and IPC IPC(7): A61B 18/18 and US Cl.: 606/41, 45, 49, 50		
Applicant SPEARS, MICHAEL DOUGLAS		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 4 sheets.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority. (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 0 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of report with regard to novelty, inventive step or industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

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TECHNOLOGY CENTER R3700

Date of submission of the demand 21 MARCH 2001	Date of completion of this report 21 DECEMBER 2001
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231	Authorized officer ROY GIBSON
Facsimile No. (703) 305-3230	Telephone No. (703) 308-3520

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/23874

I. Basis of the report

1. With regard to the elements of the international application:*

☒ the international application as originally filed
☒ the description:
pages 1-14, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of _____

☒ the claims:
pages 15-18, as originally filed
pages NONE, as amended (together with any statement) under Article 19
pages NONE, filed with the demand
pages NONE, filed with the letter of _____

☒ the drawings:
pages 1-8, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of _____

☒ the sequence listing part of the description:
pages NONE, as originally filed
pages NONE, filed with the demand
pages NONE, filed with the letter of _____

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

☒ the description, pages NONE
☒ the claims, Nos. NONE
☒ the drawings, sheets/fig NONE

5. ☐ This report has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17).

**Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/US00/23874

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement**1. statement**

Novelty (N)

Claims 1-20 YESClaims NONE NO

Inventive Step (IS)

Claims 4-6, 12-13, 19-20 ~~NO~~ **YES**Claims 1-3, 7-11, 14-18 NO

Industrial Applicability (IA)

Claims 1-20 YESClaims NONE NO**2. citations and explanations (Rule 70.7)**

Claims 1-3 and 14-16 lack an inventive step under PCT Article 33(3) as being obvious over Gosner (3,804,096).

As to claims 1-3, Gosner discloses all elements essentially as claimed except that the impedance matching circuit is not located within the handpiece of the probe assembly. Gosner, however, does disclose that the output transformer is located within the handpiece. The examiner maintains that it would have been obvious to a skillful artisan to also locate the entire impedance matching circuit within the handpiece, since this does not constitute a novel feature and which would not provide any unexpected results (Figure 9, col. 1, line 60-col. 2, line 63, col. 5, lines 47-68 and col. 8, lines 9-25).

As to claims 14-16, Gosner discloses a method for cutting human tissue using an RF probe using the steps essentially as claimed with the apparatus of claims 1-3 as obviously modified as stated above (col. 7, line 34-col. 8, line 31).

Claims 7-11 and 17-18 lack an inventive step under PCT Article 33(3) as being obvious over Gosner in view Prater et al. (4,034,761).

As to claims 7-11, Gosner fails to disclose the details of the switches which control the application of electrical energy to tissue or that the switches are located within the handpiece. But Prater et al. disclose such details as claimed and that the switches are located on the handpiece of the probe (col. 3, line 57-col. 4, lines 27 and col. 5, lines 8-18). Therefore, it would have been obvious to modify the device of Gosner, as taught by Prater et al., to provide an alternative equivalent means to switch on the electrical energy to cut or coagulate tissue as required by the procedure.

As to claims 17-18, Prater et al. further discloses the step of making contact and the details of the switch as claimed (col. 3, line 57-col. 4, lines 27 and col. 5, lines 8-18).

Claims 4-6, 12-13 and 19-20 meet the criteria set out in PCT Article 33(2)-(4), because the prior art does not teach or fairly suggest that the capacitor is electrically connected to the center tap of the transformer or that the step of making contact (Continued on Supplemental Sheet.)

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

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Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: Boxes I - VIII

Sheet 10

V. 2. REASONED STATEMENTS - CITATIONS AND EXPLANATIONS (Continued):

further comprises directing light waves through an optical fiber to the switch-contact area comprising a photodetector.

----- NEW CITATIONS -----

US 3,804,096 A (GONSER) 16 April 1974, see relevant pages
US 3,952,748 A (KALIHER et al) 27 April 1976, see relevant pages
US 5,300,068 A (ROSAR et al) 05 April 1994, see relevant pages
US 3,707,149 A (HAO et al) 26 December 1972, see relevant pages
US 3,875,945 A (FRIEDMAN) 08 April 1975, see relevant pages
US 4,034,761 A (PRATER et al) 12 July 1977, see relevant pages

INTERNATIONAL SEARCH REPORT

International application No.

PCT/US00/23874

A. CLASSIFICATION OF SUBJECT MATTER

IPC(7) : A61B 18/18

US CL : 606/41, 45, 49, 50

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 606/41, 45, 49, 50

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched
noneElectronic data base consulted during the international search (name of data base and, where practicable, search terms used)
none

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
Y	US 5,019,076 A (YAMANASHI et al) 28 May 1991, see the entire document	1-9, 12-16, 19-20
Y	US 5,071,418 A (ROSENBAUM) 10 December 1991, see entire document	1-9, 12-16, 19-20
A	US 5,911,719 A (EGGERS) 15 June 1999, see entire document	1-20
A	US 5,234,429 A (GOLDHABER) 10 August 1993, see entire document	1-20
A	US 5,376,088 A (GLAROS) 27 December 1994, see entire document	1-20



Further documents are listed in the continuation of Box C.



See patent family annex.

* Special categories of cited documents:	*T* later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
A document defining the general state of the art which is not considered to be of particular relevance	*X* document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
E earlier document published on or after the international filing date	*Y* document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art
L document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)	*G* document member of the same patent family
O document referring to an oral disclosure, use, exhibition or other means	
P document published prior to the international filing date but later than the priority date claimed	

Date of the actual completion of the international search

08 DECEMBER 2000

Date of mailing of the international search report

05 FEB 2001

Name and mailing address of the ISA/US
Commissioner of Patents and Trademarks
Box PCT
Washington, D.C. 20231

Facsimile No. (703) 305-3230

Authorized Officer

ROY GIBSON

Telephone No. (703) 308-3520

PATENT COOPERATION TREATY

PCT

NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

Commissioner
 US Department of Commerce
 United States Patent and Trademark
 Office, PCT
 2011 South Clark Place Room
 CP2/5C24
 Arlington, VA 22202
 ETATS-UNIS D'AMERIQUE
 in its capacity as elected Office

Date of mailing (day/month/year) 10 July 2001 (10.07.01)	Applicant's or agent's file reference SPER-100PCT
International application No. PCT/US00/23874	
International filing date (day/month/year) 30 August 2000 (30.08.00)	Priority date (day/month/year) 01 September 1999 (01.09.99)
Applicant SPEARS, Michael, Douglas	

1. The designated Office is hereby notified of its election made:

☒ in the demand filed with the International Preliminary Examining Authority on:

21 March 2001 (21.03.01)

☐ in a notice effecting later election filed with the International Bureau on:

2. The election ☒ was
☐ was not

made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No.: (41-22) 740.14.35	Authorized officer H. Zhou Telephone No.: (41-22) 338.83.38
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